

USSN: 10/689,942  
Atty. Docket No.: 2002B159/2  
Amendment dated January 20, 2006  
Reply to Office Action of October 21, 2005

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### REMARKS

Applicants are in receipt of the Examiner's Office Action mailed October 21, 2005 in which the Examiner: (1) rejected claims 1, 2, 10-16, and 18-26 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,631,316 to *Costemalle et al.*; (2) rejected claims 1-26 as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,620,871 to *Wilson*; (3) rejected claims 1, 2, 10-16, and 18-26 as obvious under 35 U.S.C. § 103(a) in light of *Costemalle et al.* combined with U.S. Patent No. 6,372,851 to *Theelen*; and (4) rejected claims 1-26 as obvious under 35 U.S.C. § 103(a) in light of *Wilson* combined with U.S. Patent No. 5,001,185 to *Teratani et al.*

#### § 102 Rejections

##### § 102(b) Rejection over *Costemalle et al.*

In order to anticipate under § 102(b), a prior art reference must teach every element recited in the rejected claims. See *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984) ("Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention . . ."); MPEP §§ 706.02(IV), 2131. The Examiner has rejected claims 1, 2, 10-16, and 18-26 as anticipated by *Costemalle et al.* Specifically, the Examiner states that *Costemalle et al.* discloses a composition comprising an "elastomeric random interpolymers" and a "plasticizer oil." However, the Examiner has failed to point out where in *Costemalle et al.* there is disclosed a grafted hydrocarbon resin or a grafted oligomer as is required by every claim.<sup>1</sup> The only resin disclosed in the *Costemalle et al.* patent is ESCOREZ 1102 – a non-

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<sup>1</sup> Independent claim 1 recites "a material selected from: (i) a hydrocarbon resin grafted with a graft monomer; (ii) oligomers having units selected from the group of cyclopentadiene, substituted cyclopentadiene, C<sub>5</sub> monomers, and/or C<sub>9</sub> monomers, grafted with a graft monomer, or (iii) combinations of (i) and (ii)." Independent claim 24 recites a grafted hydrocarbon resin, grafted oligomers having units selected from the group of cyclopentadiene, substituted cyclopentadiene, C<sub>5</sub> monomers, and/or C<sub>9</sub> monomers, and/or combinations thereof." Independent claim 25 recites "a grafted material obtainable by the reaction of an unsaturated acid or anhydride and (i) a hydrocarbon resin, (ii) oligomers having units selected from the group of cyclopentadiene, substituted cyclopentadiene, C<sub>4</sub>-C<sub>6</sub> (continued...)"

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grafted resin used in the comparative examples of the instant application. Thus, despite the Examiner's assertion, *Costemalle et al.* does not anticipate any of the instant claims because *Costemalle et al.* does not teach a 'grafted resin as recited in every claim. For at least this reason, Applicants respectfully request reconsideration and withdrawal of this rejection.

### § 102(e) Rejection over *Wilson*<sup>2</sup>

The Examiner as also rejected all of the pending claims over the *Wilson* reference. However, the *Wilson* reference does not disclose either a processing oil (as recited in claims 1-23 and 25-26) or a grafted resin or grafted oligomer (as recited in every claim). This deficiency is highlighted by the fact that the Examiner does not suggest otherwise. As stated above, every element recited in the claims must be disclose in order for a prior art reference to anticipate the claims of an application. It is not sufficient that "the components of the [prior art] patented invention are essentially the same as applicant's." Thus, because *Wilson* does not disclose every element of the currently pending claims, the currently pending claims cannot be and are not anticipated by the *Wilson* reference. For at least this reason, Applicants respectfully request reconsideration and withdrawal of this rejection.

### § 103 Rejections

#### § 103(a) rejection over *Costemalle et al.* and further in view of U.S. Patent No. 6,372,821 to *Theelen*

The Examiner has also rejected claims 1-26 "under 35 U.S.C. § 103(a) as being unpatentable over *Costemalle et al.*, US Patent No. 5631316 as applied to claims 1, 2, 10-16 and 18-26 above and further in view of *Theelen*, US Patent No. 6372851." Applicants are

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(...continued)

conjugated diolefins, and/or C<sub>8</sub>-C<sub>10</sub> aromatic olefins, and (iii) combinations of (i) and (ii)." Thus, because every independent claim recites a grafted resin or grafted oligomer, every dependent claim also recites a grafted resin or grafted oligomer.

<sup>2</sup> Applicants note that the Examiner cites *Wilson* under § 102(e). By pointing out the deficiencies in *Wilson*, applicants do not admit that *Wilson* is prior art. Applicants reserve the right to present evidence and swear behind the § 102(e) date of *Wilson*.

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unclear as to which claims the Examiner deems obvious in light of which reference or combination of references. However, for completeness, Applicants will assume that the Examiner has rejected every claim as obvious in light of *Costemalle et al.* alone or in combination with *Theelen*.

If the Examiner is rejecting claims 1-26 (or any subset thereof) in light of *Costemalle et al.* alone, Applicants respectfully assert that the Examiner has failed to make a *prima facie* case as such. Particularly, it is the Examiner's duty: (1) to point out the suggestion or motivation to modify *Costemalle et al.*; (2) to show a reasonable expectation of success; and (3) that the suggested modification would produce every element recited in the instant claims. MPEP § 2142. With respect to *Costemalle et al.* alone, Applicants assert that the Examiner has done none of these. Thus, to the extent the Examiner is rejecting any of the currently pending claims as obvious in light of *Costemalle et al.* alone, Applicants respectfully request withdrawal and reconsideration of this rejection.

With respect to the rejection of any of the pending claims as obvious in light of *Costemalle et al.* in light of *Theelen*, Applicants respectfully assert that there is no motivation to combine *Costemalle et al.* and *Theelen*. At most, *Theelen* teaches that it may be possible to produce a hydrocarbon resin modified with maleic anhydride which may serve as an acceptable alternative to a natural rosin. However, *Costemalle et al.* does not teach the use of a natural rosin. Thus, even if one of ordinary skill in the art were to read *Theelen* as suggesting that it would be desirable to substitute a natural rosin with a maleated hydrocarbon resin, that suggestion would have no effect on the teachings of *Costemalle et al.* because *Costemalle et al.* does not teach the use of natural rosins. Thus, Applicants respectfully suggest that the pending claims are not obvious in light of *Costemalle et al.* combined with *Theelen* and request reconsideration and withdrawal of the rejection.

§ 103(a) rejection over *Wilson* and further in view of U.S. Patent No. 5,001,185 to *Teratani et al.*

As above, Applicants are unclear as to the exact status of the rejection. However, for the sake of completeness, Applicants will assume that the Examiner has rejected every

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pending claim as obvious in light of *Wilson* alone as well as in combination with *Teratani et al.*

As with *Costemalle et al.* above, Applicants respectfully assert that the Examiner has not made a *prima facie* case of obviousness by (1) pointing out the suggestion or motivation to modify *Wilson*; (2) showing a reasonable expectation of success; and (3) showing that the suggested modification would produce every element recited in the instant claims. As discussed above with respect to anticipation, *Wilson* does not teach every element recited in the pending claims. Thus, to the extent the Examiner is rejecting any of the currently pending claims as obvious in light of *Wilson* alone, Applicants respectfully request withdrawal and reconsideration of this rejection.

With respect to the rejection of the pending claims in light of *Wilson* combined with *Teratani et al.*, without acquiescing that there is a motivation to combine the references, even if there were a motivation to combine, neither of the references teach a grafted resin or grafted oligomer as recited in every pending claim. The Examiner has not asserted otherwise. As noted above, it is the Examiner's duty to set forth a *prima facie* case that every element of the rejected claims is present in the cited prior art. The Examiner has failed to set forth a *prima facie* case. Indeed, the Examiner can not set forth a case that the combination of *Wilson* and *Teratani et al.* contain all of the elements recited in the pending claims because neither reference teaches the use of a grafted resin or grafted oligomer. For at least this reason, Applicants respectfully request that this rejection be reconsidered and withdrawn.

#### Information Disclosure Statement

The Examiner crossed through and did not consider the "Abstract from Shanghai Tire Rubber Ltd" (Reference BB) in the IDS submitted with the initial application. Applicants presume it is because, as the Examiner stated, "Prior art cited in Form 1449 must include month and year of publication to be considered." However, Applicants are unaware of the month of publication. For the Examiner's convenience, Applicants have listed the date of publication as "earlier than January 1, 2004." Thus, Applicants resubmit the Abstract from Shanghai Tire Rubber Ltd. and respectfully request consideration of said reference.

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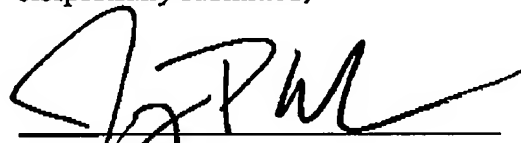
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### Conclusion

For the reasons advanced above, Applicants respectfully submit that all pending claims are patentable. Allowance of all pending claims is earnestly solicited. If the Examiner has any further comments or questions or believes that a telephone conference will assist or expedite examination of the application, the Examiner is encouraged to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge the required fee(s), or credit any overpayment, to Deposit Account No. 05-1712 in the name of ExxonMobil Chemical Company.

Respectfully submitted,

  
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